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PATENT APPLICATION
Mo-6485/LeA 33,061

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION OF)	
)	GROUP NO.: 1712
MICHAEL ZOBEL ET AL)	
)	
SERIAL NUMBER: 09/890,148)	EXAMINER: J. ROBERTSON
)	
FILED: AUGUST 27, 2001)	
)	
TITLE: POLYCARBONATE MOLDING)	
MATERIALS WITH ANTI-STATIC)	
PROPERTIES)	

REQUEST FOR REHEARING UNDER 37 C.F.R. §41.52(a)(1)

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Request for Rehearing under 37 C.F.R. §41.52(a)(1) is filed in reply to the Decision on Appeal (Appeal No. 2005-1375) mailed September 30, 2005 in the above-captioned matter and setting a two (2) month period for reply up to and including November 30, 2005.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an enveloped addressed to: Commissioner for Patents, Alexandria VA 22313-1450 11/18/05

Date

John E. Mrozinski, Jr. Reg. No. 46,179

Name of applicant, assignee or Registered Representative

Signature

November 18, 2005

Date

I. Introduction

In the Decision on Appeal, the Board affirmed the Examiner's rejection of pending Claims 2, 3, 5, 7-9, 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,937,285 issued to Wittmann et al. in view of U.S. Pat. No. 5,274,017 issued to Pan or U.S. Pat. No. 4,937,285 issued to Wittmann et al. in view of U.S. Pat. No. 5,274,017 issued to Pan taken further with evidence provided by U.S. Pat. No. 5,908,663 issued to Wang et al. This Request for Rehearing is filed under 37 C.F.R. §41.52(a)(1) in reply to that Decision¹

II. Argument

Appellants respectfully submit that the Board has misapprehended or overlooked several points in rendering the Decision which are particularly set out hereinbelow.

1. Wittmann et al.

The Board appears to have misapprehended the Appellant's argument to be that Wittmann et al. fail to teach the inclusion of a flame retardant, wherein the Board stated at page 3 of the Decision,

On page 5 of the Brief, appellants argue that "Wittmann et al. provide no teaching, nor direction, nor guidance as to how to select any flame retardant." We disagree and refer to the examiners' response, beginning on page 5 of the Answer.

¹ 37 CFR §41.52(a)(1) states that the (a)ppellant may file a single request for rehearing within two months of the date of the original decision of the Board. ... The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.

What the Appellants argued was not that Wittmann et al. failed to teach or guide one of ordinary skill in the art whether to include a flame retardant, but that Wittmann et al. failed to teach or suggest how to select any particular flame retardant. The extent of the teaching of Wittmann et al. regarding flame retardants can be found at col. 11, lines 33-40 and is reproduced below for the Board's convenience,

The polycarbonate and/or polyester carbonate moulding compositions may contain further additives which are customary for thermoplastic, aromatic polyesters, thermoplastic, aromatic polycarbonates or for thermoplastic, aromatic polyester carbonates, vinyl copolymers or for polyalkylene terephthalates, such as stabilizers, pigments, flow agents, mould-release agents, flame retardants and antistatics. (Emphasis added)

The Examiner admitted this failure of Wittmann et al. but argued that it somehow provided motivation to one of ordinary skill in the art to consult Pan at page 5 of the Answer (referred to by the Board in the passage reproduced above from the Decision) where he stated,

Second, that Wittmann provides no direction as to the selection of a particular flame retardant *actually provides* a motivation for one of ordinary skill in the art to turn to the Pan reference for particular flame retardants used in polycarbonate compositions. Thus, contrary to applicant's position, Pan does provide the missing teaching of Wittmann and does remedy the deficiencies of Wittmann. (Emphasis in original)

The Board also appears to have overlooked that Examiner failed to explain why one of ordinary skill in the art would be motivated to consult Pan as that reference teaches different polycarbonate compositions than are instantly claimed. That teaching is further addressed below.

2. Pan

The Board also misapprehended or overlooked the Appellants' argument regarding Pan wherein it stated at page 3-4 of the Decision that,

On page 5 of the Brief, appellants argue that the examiner has not shown where Pan discloses or suggests inclusion of a vinyl copolymer. The examiner does not rely upon Pan for this teaching. The examiner relies upon Wittmann for teaching this aspect of the claimed invention. See, for example, the teaching of Wittmann found in column 9, lines 54 through 62.

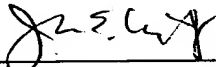
What Appellants argued at page 5 of the Brief was that because Pan does not teach the inclusion of vinyl copolymers in his aromatic carbonate polymers, the flame retardants of Pan may not be combinable with the resin of Wittmann et al. with a reasonable expectation of success. The Board also overlooked that the Examiner made no showing that the polymer art is so predictable that the inclusion (as in Wittmann et al.) or the absence (as in Pan) of a vinyl copolymer in an aromatic carbonate polymer formulation has so little effect upon the resulting resin as to render the teachings of Pan regarding specific flame retardants combinable with those of Wittmann et al.

III. Conclusion

Appellants respectfully submit that the Board has misapprehended or overlooked the above particularly-stated points in rendering the Decision. Appellants respectfully contend the above particularly-stated points clearly demonstrate that Wittmann et al. fail to teach or guide one of ordinary skill in the art in how to select any particular flame retardant. Further, Appellants believe that the Board has misapprehended or overlooked that given the unpredictability of the polymer arts, the teachings of Pan and Wittmann et al. may not be combinable with a reasonable expectation of success because Pan does not teach the inclusion of vinyl copolymers in his aromatic carbonate polymer formulations.

Therefore, Appellants respectfully submit that the Board's Decision rejecting the claims as unpatentable under 35 U.S.C §103(a) over Wittmann et al. in view of Pan or over Wittmann et al. in view of Pan taken further with evidence provided by Wang et al. is in error and request reconsideration thereof and allowance of Claims 2, 3, 5, 7-9, 12 and 13.

Respectfully submitted,

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